

REMARKS

1. Summary of the Office Action

In the Office Action mailed December 10, 2008, the Examiner rejected claims 1-2, 4, 6-8, 10-13, 15, 17-19, and 21-22 under 35 U.S.C. § 102(a) as being anticipated by United States Patent Pub. No. 2005/0071234 (Schon), rejected claims 5, 9, 16, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Schon in view of United States Patent Pub. No. 2002/0016750 (Attia), and rejected claims 3 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Schon in view of United States Patent Pub. No. 2003/0019942 (Blossom).

2. Status of the Claims

Applicant has herein amended independent claims 1, 7, 12, 18, and have amended dependent claims 3-6, 8, 9, 11, 14-17, 19-20, 22. Claims 2, 10, 13, and 21 are canceled. Currently pending are claims 1, 3-9, 11-12, 14-20, and 22, of which claims 1, 7, 12, and 18 are independent and the remaining pending claims are dependent.

3. Request for Continued Examination

A Request for Continued Examination under 37 CFR § 1.114 has been included with this response. Accordingly, Applicants request the withdrawal of the finality of the last Office Action and request further consideration of the attached amended claims on the merits.

4. Response to the Office Action with Respect to the Examiner's Rejections

a. The Examiner's rejection of claims 1-2, 4, 6-8, 10-13, 15, 17-19, and 21-22 under 35 U.S.C. § 102(a) should be withdrawn.

As set forth earlier, the Examiner rejected claims 1-2, 4, 6-8, 10-13, 15, 17-19, and 21-22 under 35 U.S.C. § 102(a) as being anticipated by United States Patent Pub. No. 2005/0071234 (Schon).

Applicants note that the Court of Appeals for the Federal Circuit has held that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). And that “the identical invention must be shown in as complete detail as is contained in the claim.” *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Applicants submit that the Schon reference fails to anticipate each and every element of the currently claimed invention.

Specifically, Applicants submit that the Schon reference fails to disclose the claim limitation of claim 1 requiring that “the RF chip comprises means for reading the ID from the memory and transmitting the ID to the second device; and the second device configured to cause the first party to be financially compensated for the network communications of the first device triggered by the RF chip based on the received ID.”

As set forth on pages 12-13 of the published international application WO 2005/064529, “To be able to use the second communication path, the customer (which can be a person or any another legal entity) generally has a subscription and pays for the amount of data transported. The paid for traffic over the second communication path would not have been there if the RF

chip didn't trigger the device. Therefore it is fair that the entity that is in control of or owns the RF chip receives a financial compensation for each triggering resulting in data traffic over the second communication path.”

Furthermore, as set forth on page 14 of the published international application WO 2005/064529, “[t]he result of having the RF chip usage logged is that the RF chip owner and detailed usage statistics are now known to the provider of the second communication path. This enables a financial compensation for each trigger to the owner of the RF chip.”

In contrast, the cited Schon reference fails to disclose any means for compensating the party in control of an RF chip for network accesses by a second device triggered by a RF signal generated by the RF chip.

In light of the forgoing, and for at least this reason, Applicants submit that claim 1 is allowable over the cited art of record, and respectfully request notice thereof be sent.

Furthermore, and for the same or similar reasons as set forth above, Applicants submit that independent claims 7, 12, and 18 are also distinguished over the cited art of record, and respectfully request notice of allowance be sent indicating their allowance.

In specific regard to dependent claims 4, 6, 8, 11, 15, 17, 19, and 22, Applicants submit that these claims inherit all of the limitations of the base claim, and as set forth above, are also in condition for allowance, and therefore request notice of allowance be sent indicating their allowance.

b. The Examiner's rejection of claims 5, 9, 16, and 20 under 35 U.S.C. § 103(a) should be withdrawn.

As set forth earlier, the Examiner rejected claims 5, 9, 16, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Schon in view of United States Patent Pub. No. 2002/0016750 (Attia).

In order to assert a *prima facie* case of obviousness under 35 U.S.C. § 103, the Examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. *MPEP §2142 rev. 6* (October 2007). *KSR International Co. v. Teleflex Inc.* requires that an Examiner provide "some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, ___, 82 USPQ2d 1385, 1396 (2007). An Examiner must "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does," *Id.* The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *Id.* The Examiner must make "'explicit' this rationale of 'the apparent reason to combine the known elements in the fashion claimed,' including a detailed explanation of 'the effects of demands known to the design community or present in the marketplace' and "'the background knowledge possessed by a person having ordinary skill in the art.'" *Id.* at 1389. The rationale must be free of the distortion caused by hindsight bias and may not rely on *ex post* reasoning. *Id.* at 1397. Anything less is not sufficient to sustain a *prima facie* case of obviousness. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006).

Based upon *KSR* and *MPEP* § 2142, the Examiner has failed to establish a *prima facie* case of obviousness, and therefore the Examiner's rejection should be withdrawn.

Specifically, and as set forth on page 5 of the Office Action, the Examiner has relied exclusively upon the Schon reference for disclosing all of the limitations of the inherited base claims 1, 7, 12, and 18. However, and as set forth above, the Schon reference fails to disclose the claim limitations of claim 1 requiring that "the RF chip comprises means for reading the ID from the memory and transmitting the ID to the second device; and the second device configured to cause the first party to be financially compensated for the network communications of the first device triggered by the RF chip based on the received ID." The Schon reference also fails to disclose the similar limitations of claims 7, 12, and 18.

For at least the reason that the Schon reference fails to disclose what the Examiner relies upon the reference as disclosing, and that the cited Attia reference does not compensate for the failed teachings of Schon, Applicants submit that the Examiner has failed to assert a *prima facie* case of obviousness with respect to claims 5, 9, 16, and 20. Accordingly, Applicants respectfully request that the rejection be withdrawn, and a notice of allowance allowing claims 5, 9, 16, and 20 be sent.

c. The Examiner's rejection of claims 3 and 14 under 35 U.S.C. § 103(a) should be withdrawn.

As set forth earlier, the Examiner rejected claims 3 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Schon in view of United States Patent Pub. No. 2003/0019942 (Blossom).

In order to assert a *prima facie* case of obviousness under 35 U.S.C. § 103, the Examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than

not. *MPEP §2142 rev. 6* (October 2007). *KSR International Co. v. Teleflex Inc.* requires that an Examiner provide "some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, ___, 82 USPQ2d 1385, 1396 (2007). An Examiner must "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does," *Id.* The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *Id.* The Examiner must make "'explicit' this rationale of 'the apparent reason to combine the known elements in the fashion claimed,' including a detailed explanation of 'the effects of demands known to the design community or present in the marketplace' and "'the background knowledge possessed by a person having ordinary skill in the art.' *Id.* at 1389. The rationale must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *Id.* at 1397. Anything less is not sufficient to sustain a *prima facie* case of obviousness. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006).

Based upon *KSR* and *MPEP § 2142*, the Examiner has failed to establish a *prima facie* case of obviousness, and therefore the Examiner's rejection should be withdrawn.

Specifically, and as set forth on page 6 of the Office Action, the Examiner has relied exclusively upon the Schon reference for disclosing all of the limitations of the inherited base claims 1 and 12. However, and as set forth above, the Schon reference fails to disclose the claim limitations of claim 1 requiring that "the RF chip comprises means for reading the ID from the memory and transmitting the ID to the second device; and the second device configured to cause the first party to be financially compensated for the network communications of the first device

triggered by the RF chip based on the received ID.” The Schon reference also fails to disclose the similar limitations of claims 7, 12, and 18.

For at least the reason that the Schon reference fails to disclose what the Examiner relies upon the reference as disclosing, and that the cited Blossom reference does not compensate for the failed teachings of Schon, Applicants submit that the Examiner has failed to assert a prima facie case of obviousness with respect to claims 5, 9, 16, and 20. Accordingly, Applicants respectfully request that the rejection be withdrawn, and a notice of allowance allowing claims 5, 9, 16, and 20 be sent.

5. Conclusion

Applicants submit that the pending claims 1, 3-9, 11-12, 14-20, and 22 are in condition for allowance and respectfully requests favorable reconsideration and allowance of all of the pending claims. Should the Examiner wish to discuss this case with the undersigned, the Examiner is invited to call the undersigned at (312) 913-0001.

Respectfully submitted,

McDONNELL BOEHNNEN
HULBERT & BERGHOFF LLP

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By: /Daniel R. Bestor/
Daniel R. Bestor
Registration No. 58,439